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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,203	01/04/2002	Katharine A. Hornung	030472.0001	6474
22467	7590	11/06/2007		
Kimberly A. Chasteen PO Box 1243 Yorktown, VA 23692			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			11/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/037,203	HORNUNG, KATHARINE A.	
	Examiner	Art Unit	
	Sara Chandler	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/037,203 (01/04/02) filed on 09/13/07.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Index-Learn – No Waiting No Wondering No Doubts (12/11/2000).

<http://www.creditability.com/secondary/lear/iLearn.asp> (hereinafter CreditAbility).

Re Claims 1-3 and 5: Creditability discloses a method for protecting against identity theft comprising:

- a. obtaining initial personal information from a consumer having a credit history (CreditAbility, pages 1-3);
- b. receiving notification of one or more changes in the consumer's credit history (CreditAbility, pages 1-3); and
- c. notifying the consumer of each change in the consumer's credit history (CreditAbility, pages 1-3).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4.6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over CreditAbility as applied to claim 1 above, and further in view of Experian Consumer Center (12/11/2000)

file://C:\\WINNT\\Profiles\\lwang\\Temporary%20Internet%20Files\\OLK4E\\Experian%20Con (hereinafter Experian).

Re Claim 4: CreditAbility discloses the claimed method supra but fails to explicitly disclose wherein step a. further comprises correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency. Experian further discloses wherein step a. further comprises correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency (Experian, pg. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

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the teachings of CreditAbility by adopting the teachings of Experian to provide a method further comprising correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency. As suggested by Experian, companies handling sensitive personal and credit information (i.e., like Experian) have a need to protect customer good will by having strong security features (e.g., protecting information from unauthorized access and inappropriate change) and privacy protection (e.g., safeguarding the confidentiality of personal credit information).

Re Claim 6: CreditAbility discloses the claimed method supra but fails to explicitly disclose wherein step c. further comprises correcting each change not verified by the consumer. Experian further discloses wherein step c. further comprises correcting each change not verified by the consumer (Experian, pg. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of CreditAbility by adopting the teachings of Experian to provide wherein step c. further comprises correcting each change not verified by the consumer. As suggested by Experian, companies handling sensitive personal and credit information (i.e., like Experian) have a need to protect customer good will by having strong security features (e.g., protecting information from unauthorized access and inappropriate change) and privacy protection (e.g., safeguarding the confidentiality of personal credit information).

Re Claim 7: CreditAbility discloses the claimed method supra but fails to explicitly disclose wherein the at least one credit agency is one or more agencies selected from the group consisting of Equifax, Experian and TransUnion. Experian further discloses

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wherein the at least one credit agency is one or more agencies selected from the group consisting of Equifax, Experian and TransUnion (Experian, pg. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of CreditAbility by adopting the teachings of Experian to provide a method further comprising wherein the at least one credit agency is one or more agencies selected from the group consisting of Equifax, Experian and TransUnion. As suggested by Experian, companies handling sensitive personal and credit information (i.e., like Experian) have a need to protect customer good will by having strong security features (e.g., protecting information from unauthorized access and inappropriate change) and privacy protection (e.g., safeguarding the confidentiality of personal credit information).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Index-Learn – No Waiting No Wondering No Doubts (12/11/2000).

<http://www.creditability.com/secondary/lear/iLearn.asp> (hereinafter CreditAbility).

in view of Experian Consumer Center (12/11/2000)

file:///C:/WINNT/Profiles/lwang/Temporary%20Internet%20Files/OLK4E/Experian%20C on (hereinafter Experian).

Re Claim 8: CreditAbility discloses method for protecting against identity theft comprising:

- a. obtaining initial personal information from a consumer having a credit history (CreditAbility, pages 1-3);
- b. obtaining a first report of personal and credit information about the consumer from at least one credit agency (CreditAbility, pages 1-3);

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c. verifying the first report of personal and credit information obtained from the credit agency with the consumer to identify incorrect personal or credit information

(CreditAbility, pages 1-3);

e. receiving notification of one or more changes in the consumer's credit history (CreditAbility, pages 1-3);

f. notifying the consumer of each change in the consumer's credit history (CreditAbility, pages 1-3); and

g. verifying each change with the consumer (CreditAbility, pages 1-3).

CreditAbility fails to explicitly disclose:

d. correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency; and

h. correcting each change not verified by the consumer.

Experian discloses:

d. correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency (Experian, pg. 1); and

h. correcting each change not verified by the consumer (Experian, pg. 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of CreditAbility by adopting the teachings of Experian to provide a method further comprising d. correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency; and h. correcting each change not verified by the consumer.

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As suggested by Experian, companies handling sensitive personal and credit information (i.e., like Experian) have a need to protect customer good will by having strong security features (e.g., protecting information from unauthorized access and inappropriate change) and privacy protection (e.g., safeguarding the confidentiality of personal credit information).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

The affidavit filed on 09/13/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the CreditAbility and Experian references as applied supra.

(1) The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the CreditAbility and Experian references.

See discussion below.

(2) a. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the CreditAbility and Experian references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

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b. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the CreditAbility and Experian references to either a constructive reduction to practice or an actual reduction to practice.

See discussion below.

First, applicant's affidavit filed 09/13/07 is not persuasive in showing conception and/or reduction to practice prior to the CreditAbility and Experian references dated (12/11/00).

As for retaining counsel on December 1, 2000, an assertion regarding obtaining legal counsel without any documentation that supports or provides a real showing that the claimed invention was known by applicants before December 11, 2000 is insufficient.

As for the first draft of the provisional patent application on December 27, 2000, the provisional patent application filed January 4, 2001 and the patent application filed January 4, 2002. All of these dates (i.e., December 27, 2000, January 4, 2001, January 4, 2002) occurred after the reference date of December 11, 2000 and the corresponding assertions referencing these dates are not evidence of reduction to practice or conception prior to the reference date of December 11, 2000.

For guidance on the types of documentary evidence that should be submitted. (See MPEP § 715.07 [R-3] Facts and Documentary Evidence)

Second, the claimed invention cannot claim the benefit of 01/04/01 provisional date for constructive reduction to practice of the claimed invention.

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The claimed invention and the specification filed with the provisional application (01/04/01) differ.

In regards to independent claims 1 and 8, the claimed invention recites that "a consumer" is the party whose identity is being protected from identity theft. A consumer is any buyer of goods and/or services. The specification (01/04/01) however, recites that a preliminary step must be performed which is receiving a subscription from the consumer for services (i.e., identity theft protection services). For example, the specification (01/04/01) recites:

For as long as **Jane Doe keeps her subscription for the services** identified in this patent current, **Company ABC will track Jane Doe's credit reports** at all three large credit reporting agencies for any change in header information (employer, address, previous addresses, etc.) or any change to her lines of credit. (See Narrative of Sample Process, Specification (01/04/01))

Only subscribing consumers can be fairly described as subscribers or as new and/or existing customers as provided in the specification (01/04/01). As demonstrated supra, the obtaining, receiving and notifying steps in the specification (01/04/01) are dependent upon the consumer becoming a subscriber and thus, the step of receiving a subscription from the consumer is a required feature of the invention described in the specification (01/04/01).

In regards to claims 2 and 7, the claimed invention recites that the information is obtained from "at least one credit agency" or "the at least one credit agency is one or more agencies selected from the group consisting of Equifax, Experian and TransUnion." The specification (01/04/01) requires that credit information is obtained from all credit agencies. For example, the specification (01/04/01) recites:

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The person assisting Jane at Company ABC first requests Jane's private information necessary to pull accurate **credit reports from each of the big three credit agencies (Equifax, TransUnion and Experian)**. (See Narrative Sample Process, Specification (01/04/01))

In regards to claims 4 and 6. The claimed invention requires active steps to be performed by the company providing identity theft protection. Claim 4 recites a method, "further comprises correcting incorrect personal or credit information in the first report of personal and credit information obtained from the credit agency." Claim 6 recites a method, "further comprises correcting each change not verified by the consumer." In the specification (01/04/01), the actions taken by the company providing identity theft protection are passive (i.e., In other words, there is no requirement that anything is actually done). For example, the specification (01/04/01) recites:

Company ABC **facilitates Jane's "investigation" with the credit agency**, to challenge the change in address information reported in the database. (See Narrative Sample Process, Specification (01/04/01))

In other words, language such as "facilitate" just means that it is easier for something to happen (e.g., easier to correct inaccurate information) but, it does not require that that something (e.g., correct inaccurate information) is actually done or that the facilitator (e.g., the company providing identity theft protection) is actually doing it (e.g., correcting the inaccurate information).

In fact, contrary to the requirements of the claimed invention, the specification (01/04/01) requires that the correction of the inaccurate information is an active step performed by the credit agency. In other words, the company providing identity theft protection may help "facilitate", "assist", "challenge", "aid" etc., but the proprietary

databases where the inaccurate data is stored and ultimately corrected is owned by and ultimately corrected according to the policies of the credit agency. For example, the specification (01/04/01) recites:

The credit reporting agencies market access to their databases to companies, who generally use the information for marketing or as an input to the decision process for extending credit to a consumer. (See Summary of the Invention, Specification (01/04/01))

Company ABC facilitates Jane's "investigation" with the credit agency, to challenge the change in address information reported in **the database**. (See Narrative Sample Process, Specification (01/04/01))

The same rationale applies to all claim dependencies.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

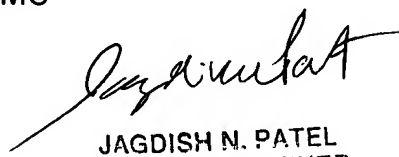
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



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PRIMARY EXAMINER